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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/567,794

02/09/2006

Ernest De Ruiter

8312-7/05.1816.6.do

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05/08/2009

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111 MONUMENT CIRCLE, SUITE 3700  
INDIANAPOLIS, IN 46204-5137

EXAMINER

MICALI, JOSEPH

ART UNIT

PAPER NUMBER

1793

MAIL DATE

DELIVERY MODE

05/08/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**ADVISORY ACTION (*continued*)**

The request for reconsideration has been considered but does NOT place the application in condition for allowance because: applicant has not made any amendments to the claims since prior to examiner issuing a final rejection. Furthermore, applicant presents the same grounds of argumentation already addressed in the previous office action (final rejection).

It is to be noted that the claim pages must define all of the claim numbers even though canceled and the claims submitted on 4/29/09 do not define the status of claims 1-17, as is required. However, to advance prosecution, a non compliant letter is not being sent out but applicants are required to correct this in any subsequent claim pages submitted.

***Response to Arguments***

**1. Applicant's arguments filed April 29<sup>th</sup>, 2009 have been fully considered but they are not persuasive.**

With regards to current argumentation, applicant relies on a previous point of contention: the references of Von Blucher and Angelo II cannot be combined, as Von Blucher teaches away from the current invention.

In response to applicant's argument that Von Blucher teaches away from the current invention and a combination with Angelo II would not be possible, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would

Art Unit: 1793

have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). With regards to that, examiner maintains one having ordinary skill in the art would look to make the process of Von Blucher continuous, and thus in doing so, would amend the structure in order to make a continuous process possible, gleaned from the reference of Angelo II. Finally, with all of this in mind, the current invention is drawn to a process, not an apparatus; thus, the test is whether one having ordinary skill would attempt to derive the process, not the apparatus.

**Included is the previous office action's response to arguments section, which still bears upon current argumentation:**

Applicant cites three reasoning for the lack of a prima facie case of obviousness; a) teaching away, b) combination would change basic principle of operation, and c) combination would render method unsatisfactory for its intended purpose.

In addressing point 1a, applicant cites that the von Blucher reference method performs its two-step process in two different apparatuses, thus teaching away from the continuous single apparatus. Examiner agrees that von Blucher does not teach a continuous single apparatus; however, examiner maintains obviousness to make continuous. This is due to the fact that it is known and preferred in the art, given the secondary references, to make such a process continuous, and that MPEP 2144.04 [R-6] covers the prima facie obviousness case of making continuous. Examiner maintains, without hindsight, that a person having ordinary skill in the art at the time the invention was made would have attempted to make the process of von Blucher continuous, regardless of the applicant's reasoning to keep as separate units.

Art Unit: 1793

In addressing point 1b, applicant argues that combination would change the basic principle of operation, requiring reconstruction and redesign of process equipment. Firstly, the current application is drawn to a process, not an apparatus; therefore, reconstruction and redesign of the apparatus is inconsequential to the process. Secondly, applicant argues that the basic principle of operation would change, due to the inability to employ “optimum” materials of construction for process equipment for optimal use. This is not sufficient to counter that a change in basic principle of operation occurs, because the selection of such materials does not change the basic principle of operation as outlined in the claims. The main issue of continuous versus discontinuous has been addressed above.

In addressing point 1c, applicant argues the inability to employ “optimum” materials of construction for process equipment for optimal use, leading the invention to not satisfactorily fulfill its intended purpose. This is not sufficient to counter that the newly modified invention would be unsatisfactory for its intended purpose, because the selection of such materials does not change the intended purpose as outlined in the claims. Once again, the main issue of continuous versus discontinuous has been addressed above.

With regards to point 2 and applicant's statement that a prima facie case of obviousness was not established, examiner maintains the initial rejection.

In addressing point 2, applicant argues that because the Schwartz reference uses only sweep gas and a different atmosphere, the reference is not pertinent. However, the reference is pertinent as it is drawn to the production of activated carbon through a furnace in a plurality of stages, and most importantly, teaches air locks or their equivalent to separate stages. That is all that's necessary for the rejections, and one having ordinary skill in the art at the time the

Art Unit: 1793

invention was made would have looked to such a reference which produces the same material and see the benefits of adding air locks or equivalent to any similar system. The main issues of continuous versus discontinuous and optimal materials for construction have been addressed above.

In addressing point 3, applicant argues that because Digre is not drawn to a process for producing activated carbon, that the pyrolysis is done in a different environment, and that the current invention is a different inventive concept from Digre, the combination does not stand. However, the use of Digre is to show knowledge in the art of using a belt-oven with regards to pyrolysis and carbonization. Applicant does not address this, so it is assumed that a belt-oven is well-established in the art of pyrolysis and carbonization; thus, the selection of a belt-oven would have been obvious to one having ordinary skill in the art at the time the invention was made. The main issues of continuous versus discontinuous, optimal materials for construction, and being unsatisfactory for its intended purpose have been addressed above.

In addressing point 4, applicant argues that because Giebelhausen is silent with respect to sulfonation of the carbon, that the raw materials are treated in a dryer and only afterwards transferred to a second kiln, the combination does not stand. However, the use of Giebelhausen is to definitively show that a process control of setting the speed at which material moves through the apparatus is well-established in the art of activated carbon production; thus, the addition of a speed setting process control would have been obvious to one having ordinary skill in the art at the time the invention was made. The main issues of continuous versus discontinuous, optimal materials for construction, and being unsatisfactory for its intended purpose have been addressed above.